

REMARKS

This application has been amended so as to place it in condition for allowance at the time of the next Official Action.

Prior to considering the merits of the objections and rejections made in the Official Action of November 7, 2005, applicants will first address the finality of such Official Action.

The Official Action of November 7, 2005 is the second action on the merits in the present application. It follows the first action on the merits mailed July 29, 2005, and the responsive amendment of October 6, 2005. The finality of a second action on the merits is proper in many, but not all, situations. As specifically noted in MPEP §706.07(a), the U.S. Patent Office has effected a change in practice regarding finality of second actions. The above-identified section states:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(b)." (emphasis added)

In the present application, the first action on the merits of July 29, 2005 explicitly characterized claims 10-12 as allowable but for identified rejections under 35 USC §112, second paragraph as well as their dependence from rejected base claims. As noted in the paragraph spanning pages 9 and 10 of the

responsive amendment filed October 6, 2005, it was in reliance on this statement of allowability that the applicants amended claim 1 to incorporate the features of claim 10, and amended each of claims 11 and 12 into independent form.

In the Official Action of November 7, 2005, each of amended claims 1, 11, and 12 is rejected based on prior art. Accordingly, the rejection of claims 1, 11, and 12 amounts to a new ground of rejection neither necessitated by applicants' amendment of the claims nor based on information submitted in an Information Disclosure Statement as defined in the cited MPEP passage above. In accordance with MPEP §706.07(c), applicants hereby suggest that the finality of the most recent Official Action is improper, and respectfully request that the finality of such action be withdrawn.

The Official Action rejects claims 1, 2, 4-9, and 11-13 under 35 USC §112, first paragraph as failing to comply with the written description requirement. The Official Action identifies the language that underlies this rejection, and helpfully provides recommendations for amendments to overcome such rejection. Applicants have amended each of claims 1, 11, and 12 to incorporate the recommended changes, and reconsideration and withdrawal of this rejection are therefore respectfully requested.

The Official Action rejects the same set of claims under 35 USC §112, second paragraph as being indefinite. Again

the Official Action helpfully provides suggested amendments to overcome this rejection, and applicants have amended claims 1, 11, and 12 to incorporate such suggestions. Reconsideration and withdrawal of this rejection are therefore respectfully requested.

The Official Action rejects as unpatentable under 35 USC §103(a) the following sets of claims based on the identified combinations of references: claims 1 and 11-13 over MANDAI et al. (MANDAI '584) in view of Japan 2000-176343 ('343); claims 2 and 4-9 over MANDAI '584 in view of '343, and further in view of Japan 05-329432 ('432); claims 1, 2, 4, 11, and 12 over TOMARU in view of '432 and '343; and claims 5-8 over TOMARU in view of '432 and '343, and further in view of MANDAI et al. U.S. 2001/0002281. Reconsideration and withdrawal of each of these rejections are respectfully requested for the following reasons:

In addition to the amendments discussed above, applicants have amended each of claims 1, 11, and 12 to incorporate the features of claim 2. As necessitated by such amendment, applicants have canceled claim 2 and amended claim 4 to depend directly from amended claim 1.

Each of the outstanding rejections relies upon at least one of the MANDAI '584 and '432 references. The teachings of these two references are therefore integral to each outstanding rejection. In light of the features of these references, applicants respectfully suggest that none of the present

rejections can reasonably be maintained against the claims as now amended.

The MANDAI '584 reference discloses that the web 12 is put in contact with the head by a pair of rollers, as shown in Figure 1 of such reference. In stark contrast, in the present invention the web is not placed in actual contact with the head or lip lands thereof. The '584 reference also specifically teaches that the lip land is round, which is entirely contrary to the flat lip lands as now recited. The features described above in connection with the '584 reference apply equally to that of the applied TOMARU reference.

The '432 reference describes structure at least in paragraph [0005] in which the bottom lip 5 does not extend as far as the upper lip 6. This is offered as a characteristic to avoid contact between the base material film 3 and the bottom lip 5, in contrast to upper lip 6.

Accordingly, the '432 reference, like the '584 and TOMARU references considered above, specifically teaches contact between at least one of the lip lands and the film upon which the coating is being applied. This lies in stark contrast to the present invention in which both the lip lands lie at a distance from the web being coated. This characteristic of the present invention is made even more explicit by way of newly added claims 14-16 which depend, respectively, from independent claims 1, 11, and 12.

In light of the amendments described above and the arguments offered in support thereof, applicants believe that the present application is in condition for allowance, and an early indication of the same is respectfully requested.

As noted at the beginning of the present Remarks section, even if the present amendments do not result in an indication of allowance of all pending claims, the finality of the previous Official Action is believed to be improper and should be withdrawn.

If the Examiner has any questions or requires further clarification of any of the above points, the Examiner may contact the undersigned attorney so that this application may continue to be expeditiously advanced.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



Robert J. Patch, Reg. No. 17,355
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297

RJP/fb